

REMARKS

I. INTRODUCTION

Claims 68-136 are under consideration in the above-referenced application.

II. REJECTION UNDER 35 U.S.C. § 103(a) SHOULD BE WITHDRAWN

Claims 68-136 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,485,413 issued to Boppart et al. (the “Boppart Patent”), in view of U.S. Patent No. 5,801,826 issued to Williams (the “Williams Patent”). It is respectfully asserted that for at least the reasons set forth herein below, this 35 U.S.C. § 103(a) rejection is improper, and should therefore be withdrawn.

Without addressing whether the referenced cited by the Examiner to reject claims 68-136 under 35 U.S.C. § 103(a) are appropriate, Applicants respectfully assert that the Boppart Patent cannot be used in combination with the Williams Patent to render these claims unpatentable under 35 U.S.C. § 103(a).

In particular, the present application was filed as November 10, 2000, and the Boppart Patent issued on November 26, 2002. Accordingly, the present application was filed less than one (1) year from the issue/publication date of the Boppart Patent, and thus, the Boppart Patent is likely being considered by the Examiner as a 35 U.S.C. § 102(e) reference.

However, 35 U.S.C. § 103(c) states that:

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter

and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The present application was assigned by the inventors thereof to The General Hospital Corporation via an assignment which was recorded with the U.S. Patent and Trademark Office (the "Patent Office") at reel/frame 011792/0968 on May 14, 2001. The application which matured into the Boppart Patent was assigned by the inventors thereof to Massachusetts Institute of Technology via an assignment which was recorded with the Patent Office at reel/frame 009174/0876 on May 11, 1998. Thereafter, Massachusetts Institute Of Technology assigned this application which matured into the Boppart Patent to The General Hospital Corporation via an assignment which was recorded with the Patent Office at reel/frame 011801/0817 on May 14, 2001. Thus, both the present application and the Boppart Patent are assigned to The General Hospital Corporation.

Accordingly, because the Boppart Patent is a 35 U.S.C. § 102(e) reference, and since the present application and the Boppart Patent are owned by the same entity (i.e., The General Hospital Corporation), the Boppart Patent cannot be used to reject claims 68-136 under 35 U.S.C. § 103(a). Without combining the Boppart Patent with the Williams Patent, the William Patent fails to teach or suggest the subject matter recited in claims 68-136 of the above-referenced application, as effectively admitted by the Examiner in the Office Action, page 2, lines 13-19.

Therefore, withdrawal of the § 103(a) rejection of claims 68-136 is respectfully requested for at least the reasons presented herein above.

III. **CONCLUSION**

In light of the foregoing, Applicants respectfully submit that all pending claims 68-136 are in condition for allowance. Prompt consideration, reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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